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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,711	10/10/2000	Pallab K. Chatterjee	020431.0706	4657
7590	09/23/2004		EXAMINER	
Baker Botts LLP 2001 Ross Avenue Dallas, TX 75201-2980			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/686,711	CHATTERJEE ET AL.
	Examiner Siegfried E. Chencinski	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11, 13-23 and 25-44 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11, 13-23 and 25-44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1. Claims 1-11, 13-23 and 25-36 are rejected** under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (US Patent 4,799,156, hereafter Shavit).

**Re. Claims 1, 13 & 25,** Shavit anticipates a computer-implemented marketplace, method and system for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

- a database containing (Col. 2, lines 25-27);
- registration information for one or more types of transactions available to participants through the marketplace (subscription/registration – Col. 6, lines 4-6; transactions available/options – Col. 6, lines 29-31);
- participation criteria for each participant specifying one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant (Fig. 2; Col. 6, lines 4-9); and
- one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42);
- the marketplace operable to initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial

transaction service to at least one participant involved in the ongoing transaction (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42); and

- monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction (Fig. 8, 224-234; Col. 20, l. 64 – Col. 21, l. 36).

**Re. Claims 2 & 14,** Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a time limit for a transaction or one or more aspects thereof (Urgent Shipment - Col. 6, l. 55; late shipment - Col. 10, l. 36).

**Re. Claims 3 & 15,** Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a payment point, the marketplace operable to generate payment instructions for communication to a participant in response to a transaction reaching the payment point (Fig.'s 14 (344), 15 (354), 16 (390); Col. 8, ll. 55-64).

**Re. Claims 4 & 16,** Shavit anticipates a marketplace of Claim 1, wherein at least some of the participation criteria is selected from the group consisting of item type information, value information, and delivery information (Col. 5, l. 65 – Col. 6, l. 51).

**Re. Claims 5 & 17,** Shavit anticipates a marketplace of Claim 1, wherein the participation criteria for at least one participant comprise default criteria specifying all types of transactions (Col. 5, l. 65 – Col. 6, l. 51).

**Re. Claims 6 & 18,** Shavit anticipates a marketplace of Claim 1, wherein the initiated process comprises at least one associated person to assist in providing the corresponding service (Col. 5, l. 34).

**Re. Claims 7 & 19,** Shavit anticipates a marketplace of Claim 1, wherein the specified event comprises the initiation of the associated commercial transaction (Col. 6, ll. 19-25, 34, 37-38).

**Re. Claims 8 & 20,** Shavit anticipates a marketplace of Claim 1, wherein the initiated process is operable to initiate a transfer of funds on behalf of the participant (Col. 8, l. 55 – Col. 9, l. 6).

**Re. Claims 9 & 21,** Shavit anticipates a marketplace of Claim 8, wherein the transfer of funds is made by a financial agent of the participant to a financial agent of a second participant through the marketplace (Col. 8, l. 65 – Col. 9, l. 19; among some agent to agent combinations are bank to bank, lender to bank, or bank to factor,).

**Re. Claims 10 & 22,** Shavit anticipates a marketplace of Claim 8, wherein the initiated process is operable to generate information for communication to one or more enterprise resource planning (ERP) systems associated with the participant (Col. 1, ll. 5-12; Col. 1, l. 24 –Col. 2, l. 5. ERP systems are computer software systems which link purchasing/materials, accounting and manufacturing. The user systems anticipated by Shavit are the enterprise systems which existed in the middle 1980's and which have grown in sophistication since then. The ASK Manman ERP system was one of the leading old enterprise systems which was then supplanted in the middle 1990's by ERP systems provided by SAS, Baan, Oracle and others).

**Re. Claims 11 & 23,** Shavit anticipates a marketplace of Claim 1, wherein at least one of the processes is a participant qualification process operable to determine the acceptability of the participant and of one or more financial agents:

- from which the participant may select (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6); and
- from or to which funds may be transferred on behalf of the participant (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6).

**Re. Claims 26, 31 & 36,** Shavit anticipates software and a method operating at a computer-implemented marketplace for settling a commercial transaction between a buyer and a seller, the software being embodied in a computer-readable medium and when executed operable to:

- receive an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-

qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction (Fig. 3; Col. 1, I. 9-36; Col. 5, II. 16-24; Col. 6, II. 2-18, 34; Col. 15, II. 7-13);

- communicate the order to the seller for fulfillment of the order (Col. 2, II. 21-26; Col. 5, II. 39-50; Col. 7, II. 1-5; Col. 8, II. 12-15);
- receive notification from the seller in response to shipping of the item (Col. 11, II. 11-21, 55);
- receive notification from the buyer in response to acceptance of the item (Col. 9, II. 26-27);
- communicate payment instructions to at least one financial agent associated with the buyer (Col. 8, II. 55-58);
- receive payment from the financial agent associated with the buyer (Col. 8, I. 55 – Col. 9, I. 19);
- communicate the payment to a financial agent associated with the seller (Col. 8, II. 55-58);
- receive notification from the seller in response to acceptance of the payment (Fig. 15 - managing payee's and payer's statement info.; Fig. 16 – statements and reports);
- communicate accounting information reflecting settlement of the transaction (Fig. 16 – statements and reports); and
- monitor activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions (Fig. 8, 224-234; Col. 20, I. 64 – Col. 21, I. 36).

**Re. Claims 27 & 32,** Shavit anticipates software of Claim 26, further operable to communicate the order to a financial agent associated with the buyer or the seller (Fig. 2; Col. 5, I. 66 – Col. 6, I. 18; Col. 8, II. 23 – 41, 55-58).

**Re. Claims 28 & 33,** Shavit anticipates software of Claim 26, wherein the financial agent associated with the buyer is integral to the buyer (Inherent, e.g. when the buyer is a financial institution).

**Re. Claims 29 & 34,** Shavit anticipates software of Claim 26, wherein the financial agent associated with the seller is integral to the seller (Inherent, e.g. when the seller is a financial institution).

**Re. Claims 30 & 35,** Shavit anticipates software of Claim 26, further operable to communicate the accounting information to enterprise resource planning (ERP) functionality associated with the buyer or the seller (Supra. See claims 10 & 22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 37 - 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al.

**Re. Claims 37, 39, 41 & 43,** Shavit discloses a system wherein participants are pre-qualified using one or more of:

- one or more qualification ratings (Fig's 3, 4, 6, 8); and
- one or more qualification categories (Col. 6, II. 9-18).

Shavit does not explicitly disclose one or more qualification rankings. However, Shavit's disclosure in col. 6, II. 9-51 discloses a variety of optional qualifications a participant can register for which essentially establishes a ranking system established by the different mix and levels of participation of the various participants. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that a qualification rankings were suggested by Shavit based on these options offered by Shavit in order to

offer dramatic new automated efficiencies to prospective and current participants in an electronic marketplace system (Shavit, Col. 1, ll. 61- 68).

**Re. Claims 38, 40, 42 & 44,** Shavit does not explicitly disclose a system wherein the marketplace is further operable to automatically modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate. However, Shavit discloses an electronic marketplace wherein the marketplace is further operable to automatically modify a variety of information of participants based on automated interactive information service with the participant's computer information systems, including the activities of the participant in the ongoing transaction (Col. 8, ll. 5-22). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate based on the interactive information exchange taught by Shavit to the dramatic new automated efficiencies made available to prospective and current participants in an electronic marketplace system (Shavit, Col. 1, ll. 61- 68).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-11, 13-13 and 25-44 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendments.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3628

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

September 20, 2004



HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
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